



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

CHANG et al.

Serial No. 09/739,990

Filed: December 18, 2000

For: HANDY ELECTRIC SEALER
WITH SAFETY MEANS .

Group Art Unit: 3742

Examiner: Van, Q.

CERTIFICATE OF MAILING

I hereby certify that this correspondence and fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on 11/25/02, Express Mail Label No. E-7174-740705 US by Michelle Daugherty [Signature]

BRIEF ON APPEAL

The Assistant Commissioner for Patents
Washington, D.C. 20231

5

Sir:

RECEIVED

DEC 03 2002

TECHNOLOGY CENTER R3700

This Appeal Brief is being filed in triplicate together with a check for \$160.00 to cover the appeal fee and a second check for \$200.00 to cover a two month extension of
10 time under 37 C.F.R. 1.136(a). If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 10-0440.

This is an appeal from the decision dated January
15 24, 2002, finally rejecting claim 44 under 35 U.S.C. §103(a) as being unpatentable over Chou, U.S. Patent 5,142,123 (hereinafter "Chou '123"), in view of Netherlands Patent

11/29/2002 NMOHAMM1 00000041 09739990

02 FC:2402

160.00 OP



542,359 (hereinafter "Hawaii '359") and Taiwanese Patent
No. 040,687 (hereinafter "Taiwanese '687").

REAL PARTY IN INTEREST

The real party in interest is Welcome Company, Ltd.,
5 the assignee of the subject application.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known
to Appellants that will directly affect or be directly
affected by or have a bearing on the Board's decision in the
10 pending appeal.

STATUS OF THE CLAIMS

Claims 37-39 and 43 are allowed but are being
canceled in an accompanying amendment as these claims are the
subject of a continuation application previously filed.
15 Claims 46-48 are withdrawn from consideration. Claim 44 is
the subject of this appeal.

STATUS OF AMENDMENTS

Claim 44 has not been amended after the rejection.
Claims 37-39 and 43 are being canceled in an accompanying
20 amendment.

RECEIVED

DEC 03 2002

TECHNOLOGY CENTER R3700

SUMMARY OF THE INVENTION

The present invention provides a switching mechanism, integrated into the sealer and activated by the operation of a metal press plate secured to a press bar, which eliminates the need for the user to activate separately a switch before the sealer may be used.¹ The switching mechanism also eliminates the erroneous operation of the sealer.² In one embodiment of the invention, the sealer includes a press bar with one end being pivotally connected to the housing of the sealer, the press bar having a metal press plate located at the pivotally connected end that normally biases the free end of the press bar open.³ A switch, which controls the open/closed state of the circuitry of the heating element, is located underneath the metal press plate on the connected end of the housing of the sealer.⁴

When the press bar of the sealer is pressed down by the user to move the heating element towards the heat insulative block, the metal press plate engages the switch, thereby closing the circuitry of the heating element and activating it.⁵ When the user releases the press bar, the metal press plate disengages from the switch and turns off

¹ Specification, Page 1, lines 17-18. See also Figure 20. In the Brief, all references to the Specification are to the Substitute Specification filed by Appellant in the Amendment and Request for Reconsideration dated August 3, 2001, a copy of which is enclosed.

² Specification, Page 1, lines 21-24.

³ Specification, Page 15, lines 6-8.

⁴ Specification, Page 15, lines 11-12. Figures 20 and 21.

the heating element.⁶ The integration of the switch mechanism into the housing of the sealer and the use of the metal press plate in the press bar to activate the heating element eliminates the need for a user to activate a separate switch, and, just as importantly, deactivate a separate switch, thereby avoiding the occurrence of the sealer being left on due to a switch that has not been turned off by the user.

ISSUES

10 The main issue in the present case is whether the Examiner made a *prima facie* case of obviousness under 35 U.S.C. §103. Specifically:

1) Is the combination of Chou '123, Netherlands '359 and Taiwanese '687 proper in the 35 U.S.C. §103 rejection in that there was a motivation to combine contained in the references?

2) Even assuming the combination of Chou '123, Netherlands '359 and Taiwanese '687 is proper, would the combination have made the claimed invention obvious?

GROUPING OF THE CLAIMS

Claim 44 is the only claim in this appeal.

⁵ Specification, Page 15, lines 12-18. Figure 21.

⁶ Figure 20.

ARGUMENT

As stated in In re Rouffet, "to reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness . . . In the
5 absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent."⁷

To establish a *prima facie* case of obviousness, the Examiner must meet at least two basic criteria: (1) show that
10 there was some suggestion or motivation to modify the reference or to combine reference teachings; and (2) show that the prior art references, when combined, must teach or suggest all the claim limitations.⁸ Most importantly, the teaching or suggestion to make the claimed combination must
15 be found in the prior art and not based on applicant's disclosure.⁹

Appellant submits that the Examiner has not met the burden of satisfying the above-listed criteria to establish a *prima facie* case of obviousness in that the Examiner has not
20 shown that there is a motivation to combine the references, nor has the Examiner shown that the combined references teaches or suggests the claim limitations.

⁷ In re Rouffet, 149 F.3d 1350, 1355 (Fed. Circ. 1998).

⁸ In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁹ In re Vaeck, at 493.

I. There is no motivation to combine contained in Chou '123,
Netherlands '359 and Taiwanese '687.

The Examiner alleges that a person of ordinary skill in the art would have been motivated to combine the teachings of Netherlands '359 and Taiwanese '687 with Chou '123. However, the Examiner has failed to adduce any support for the suggestion or desirability of modifying Chou '123 using Netherlands '359 and Taiwanese '687 in the Examiner's attempt to construct Appellant's claimed invention.

10 In fact, Appellant submits that, in Taiwanese '687, there is a teaching away of the combination that the Examiner proposes with Netherlands '359. Specifically, Taiwanese '687 disparages sealers that are powered by alternating current (AC) power supplies, which is exactly the type of sealer
15 disclosed by Netherlands '359.¹⁰ In addition, one of the objectives that Taiwanese '687 attempts to achieve includes a smaller, portable design, which is opposite to what is taught by Netherlands '359.¹¹ Thus, instead of looking to Netherlands '359, one of ordinary skill in the art would
20 actually look away from the teachings of that reference.

As there is no suggestion in the references for the combination urged by the Examiner, it would thus appear that the only logical conclusion is that the Examiner relied on

¹⁰ See Taiwanese '687, English translation, page 2, first full paragraph.

¹¹ Compare Netherlands '359 Figure 1 to Figure 4.

impermissible hindsight to reconstruct the claimed invention from the prior art. Appellant submits that as there has been no showing of a motivation to combine the references, the combination of Netherlands '359 and Taiwanese '687 with Chou
5 '123 is improper and therefore the 35 U.S.C. §103 rejection should be reversed.

II. Even assuming the combination of Chou '123, Netherlands '359 and Taiwanese '687 is proper, the combined references neither teach nor suggest the combination as
10 taught by appellant.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of
15 reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."¹²

As described above, one of the salient features of Appellant's sealer is the use of a press plate, mounted to
20 the press bar of the sealer, to activate a switch to close an electric circuit between the current source and the heating element. The switch is activated when the press bar is pressed downward toward the base because the metal press

¹² Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

plate comes in contact with the switch, which is partially contained in the base. Through the use of this mechanism, the heating element is energized only when the user is in the actual process of sealing a bag.

5 Appellant's claim 44 recites the limitation of
" [the] metal press plate [being] secured to [the] press bar."
Importantly, and as admitted by the Examiner, the references do not show this claim element. However, the Examiner alleges that it would have been obvious to one of ordinary
10 skill in the art to secure a metal press plate to a press bar of a hand-held electric sealer because it has been held that rearranging parts of an invention involves only routine skill in the art, referring to In re Japikse, 86 U.S.P.Q. 70 (1950) (Holding that the rearrangement of a part where the
15 rearrangement does not affect the operation of the device-- e.g., moving a switch from one location to another--is not inventive).

Appellant submits that the interaction between the press bar, the metal press plate and the switch is achieved
20 by more than just a rearrangement of a part, as the operation of the device is modified if the parts are not in Appellant's claimed arrangement (versus In re Japikse, where a switch, which is self-contained, may be moved anywhere and still perform the same function). For example, if the press plate
25 is moved to another location, the function of the press plate

would be changed from being a biasing and a switch activation mechanism to being a biasing means only, and requiring another mechanism to activate the switch. Hence, there are functional and performance motivations to securing the metal
5 press plate to the press bar that cannot simply be relegated to being a mere rearranging of parts.

Appellant further submits that the references, specifically Taiwanese '687, in fact teaches away from securing the metal press plate to the press bar as doing so
10 would require that the wire connecting the metal press plate to the power source be extended so that it would still reach the metal press plate.¹³ In addition, once the wire is extended, it would have to be placed such that it remains out of the way. Even one not of ordinary skill in the art can
15 see that this is not desirable as this adds complexity to the construction of the sealer.

Again, it seems that the Examiner is employing impermissible hindsight reconstruction and, lacking any support for the rejection, the Examiner relies on the
20 conclusory allegation that securing the metal press plate to the press bar to switch a circuit off/on (a feature not shown in any of the references), is obvious because doing so is the

¹³ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

mere rearrangement of a part of a device. The Examiner does not provide any support regarding motivation to "rearrange" the parts so that the metal press plate is secured to the press bar rather than to the base of the electric sealer.

5 In view of the foregoing, it is respectfully submitted that the claimed elements are neither described nor suggested by the combined teachings of Chou '123, Netherlands '359 and Taiwanese '687. And further, the teachings of these references would not have led one of ordinary skill to
10 provide a heating unit mounted in a press bar such that when a free end of the press bar is pivoted downwardly to the metal press plate, it causes a circuit between the heating unit and a source of current to close.

 It is believed that the above statements
15 demonstrate that the cited reference(s) do not render obvious the presently claimed invention as required by 35 U.S.C. §103. Absent an adequate teaching in the reference(s), this rejection cannot stand and should be reversed.

CONCLUSION

20 Appellant submits that the Examiner has failed to make a *prima facie* case of obviousness in that Appellant has shown that the proposed combination of Chou '123, Netherlands '359 and Taiwanese '687 was improper as there was no showing of a motivation to combine in the references. In addition,

it has been shown that, even if the proposed combination is proper, it fails to suggest to one of ordinary skill in the art to provide the claimed invention. In the absence of such a suggestion, the subject matter of the claims at issue cannot be considered obvious under 35 U.S.C. §103.


For the foregoing reasons, it is submitted that the final rejection is not in accordance with the Patent Statute and Appellant respectfully requests that it be reversed.

10

Respectfully submitted,

Date:

11/25/02


Rod S. Berman, Esq.

Reg. No. 31,483

George G. C. Tseng, Esq.

Reg. No. 41,355

15

JEFFER, MANGELS, BUTLER & MARMARO LLP
Seventh Floor
20 1900 Avenue of the Stars
Los Angeles, CA 90067
Tel: (310) 203-8080

Claim on appeal:

44. A hand-held electric sealer comprising

a) a housing,

b) a press bar having a free end, said press bar

5 being pivotally connected to said housing,

c) a metal press plate remote from said free end
of said press bar for normally biasing said press bar in an
open position, wherein said metal press plate is secured to
said press bar,

10 d) a heating unit,

e) a source of current, and

f) circuitry electrically connecting said
heating unit and said source of current, wherein said
circuitry is normally in an open state,

15 wherein when said free end of said press bar is
pivoted downwardly said metal press plate switches said
circuit from an open state to a closed state.

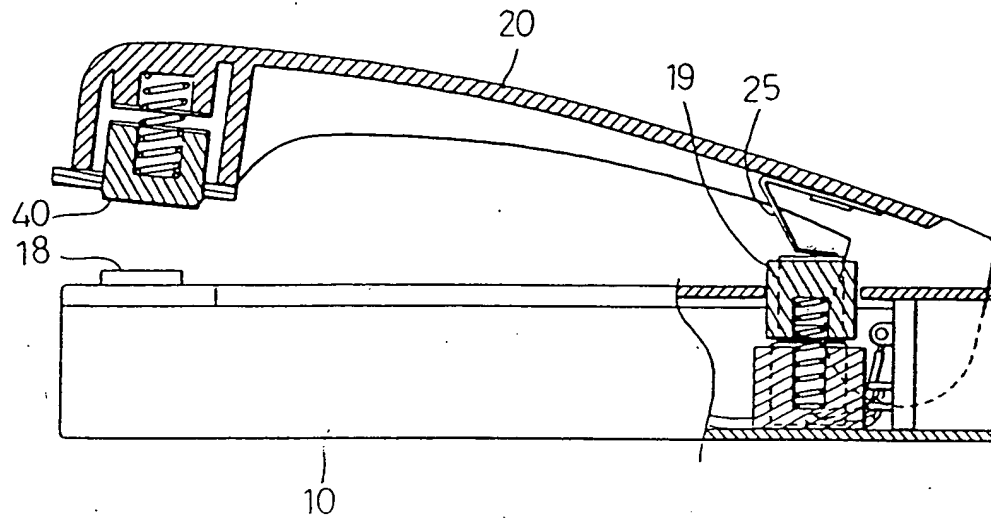


FIG. 20

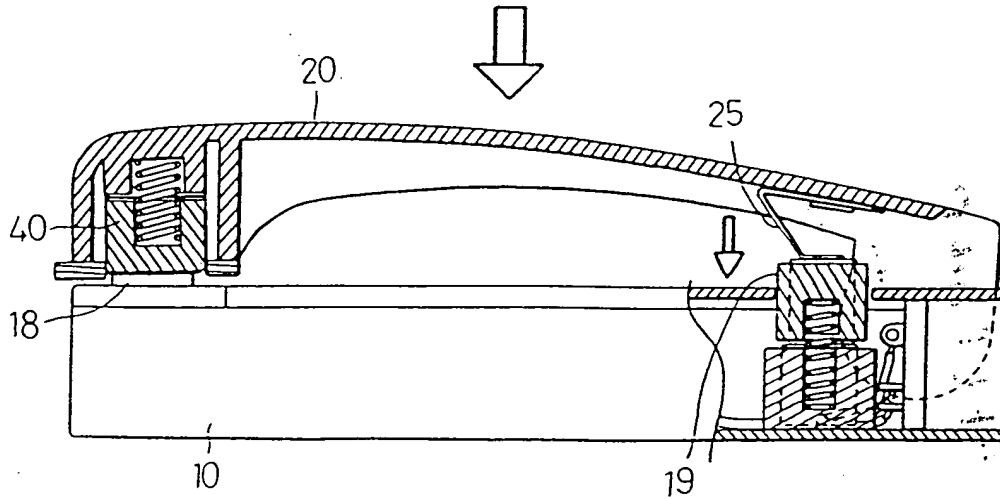


FIG. 21

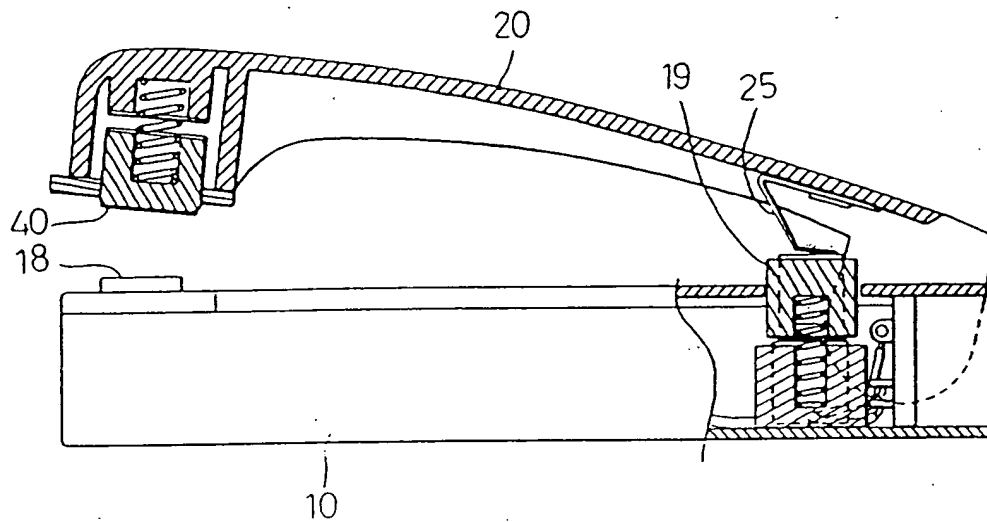


FIG. 20

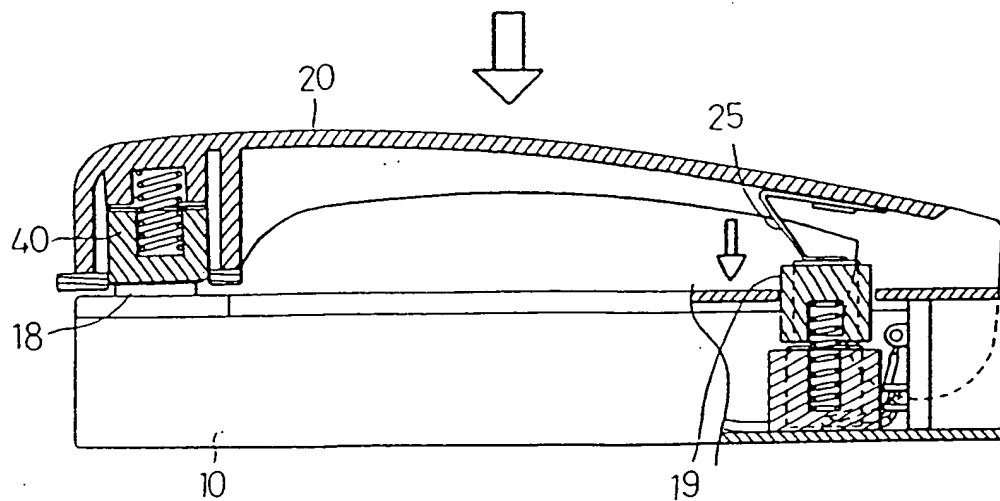


FIG. 21